

### **REMARKS**

Claims 1-3, 5, 7-10 and 12 have been rejected and claims 4, 6 and 11 have been objected to. Claims 13-20 have been added. Support for the added claims can be found in the specification on page 5, lines 5-32, bridging to page 6, lines 1-31, bridging to page 7, lines 1-3, Fig. 1, Fig. 3 and Fig. 5. Claims 13-20 remain for prosecution. No new matter has been added.

The specification has been amended to recite the relationship between the instant application and U.S. Pat. Appln. Ser. No. 09/762,863, which relationship has been noted in the enclosed supplemental declaration.

The rejections and objections of the Examiner shall be taken up in the order presented in the Office Action.

2. Claims 1-3, 5, 7-10 and 12 have been rejected under 35 U.S.C. §103(a) as being obvious in view of Franke (U.S. Patent 5,094,517) and Taylor et al. (U.S. Patent 6,281,976).

Independent claim 1 recites an optical waveguide sensor comprised of functionally cooperating structure that is, "capable of measuring up to at least 2000  $\mu\epsilon$  when the housing is stressed." See cl. 1, emphasis added.

The Examiner contends that the above functional limitation should not be accorded patentable weight<sup>1</sup>. However, as the rejection of claim 1 is an obviousness rejection, not an anticipation rejection, the Examiner must not only accord patentable weight to the above functional limitation, but must also demonstrate how the prior art suggests the above functional

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<sup>1</sup> On page 2 of the Office Action, the Examiner states, "With regards to the use of the "capable of measuring...", it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation in any patentable sense."

limitation. See In re Mills, 916 F.2d 680, 682-683 (Fed. Cir. 1990). The Examiner's failure to accord patentable weight to the above functional limitation renders the obviousness rejection improper. Thus, it is submitted that the obviousness rejections of claim 1, and claims 2-12 dependent thereon, have been obviated.


Moreover, one of skill in the art would not modify the optical sensor disclosed in Franke with the optical fiber disclosed in Taylor et al. to produce the optical waveguide sensor of claim 1, which is comprised of functionally cooperating structure that is capable of measuring up to at least 2000  $\mu\epsilon$  when the housing of the optical waveguide sensor is stressed, because Franke is directed to an optical sensor structured to detect and measure liquids in the vapor phase, not measure strain. In view of the foregoing, Applicants' respectfully request that the obviousness rejections of claim 1, and claims 2-12 dependent thereon, be withdrawn.

It is submitted that added claims 13-20 are patentably distinguishable from the cited art for the same reasons as claim 1-12.

3. The indication that claims 4, 6 and 11 contain allowable subject matter is acknowledged and appreciated.

Applicants submit that the application is now in condition for allowance and respectfully requests early favorable action by the Examiner.

Respectfully submitted,



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